

**Application No.:** 10/537,320  
**Filing Date:** June 2, 2005

### **REMARKS**

Claims 7, 9, 12 and 13 have been amended. New claims 14-17 have been added. Support for the amendments is found in the existing claims and the specification as discussed below. Accordingly, the amendments do not constitute the addition of new matter. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

#### **Priority**

The Examiner has acknowledged the claim for foreign priority and receipt of the priority documents. It is not necessary to submit an English translation at this stage as there is no intervening reference. The Rule 41 sections cited by the Examiner in the Office Action relate to contested cases and interferences. Should there be any indication that an interference might be declared, Applicants will submit a certified English translation of the Japanese priority document.

#### **Specification**

A substitute specification is submitted herewith in response to the Examiner's objection. The specification has been reworded in idiomatic English. The amendments introduced with the Preliminary Amendment of June 2, 2005 have been incorporated. Both marked and clean versions are submitted. No new matter is added.

#### **Rejection under 35 U.S.C. § 112, second paragraph**

Claims 7, 9, and 12-13 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action states that it is not clear "who are the individuals that are in need of inhibition of elongation of melanocytic dendrites or what "disease"/ "condition" elongation of melanocytic dendrites is associated with" (Office Action, page 5, first paragraph) .

Responsive to the rejection, Applicants have replaced "an individual in need thereof" in claims 7 and 12 with "an individual in need of skin whitening". Claims 7, 9, 12, and 13 are

directed to a method of whitening skin to correct “dark complexion” (claim 9). Support for the amendment is found throughout the specification. See page 2, first full paragraph; pages 9-10, bridging paragraph; page 16, 1<sup>st</sup> partial paragraph, page 18, 1<sup>st</sup> paragraph of Example 4. Support for the term “dark complexion is found specifically in the first paragraph of Example 2 on page 15. Support is found generally in the Background section of the application (pages 1-3).

The claims are now directed to a specific corrective action which is associated with a need to inhibit elongation of melanocytic dendrites. The population “in need thereof” would be clear to one of ordinary skill in the art such as a dermatologist or anesthetist.

Furthermore, new claims 14-17 are added in which Applicants have replaced “an individual in need thereof” with “an individual in need of a treatment for dyschromatosis”. Applicants also provide the attached definition from online source which defines “dyschromatosis” as “an asymptomatic anomaly of pigmentation occurring among the Japanese; may be localized or diffuse”. Support for the amendment is found throughout the specification but particularly on page 13, last full paragraph.

Both amended claims 7, 9, and 12-13 and new claims 14-17 clearly recite a specific treatment or disease which is associated with a need to inhibit elongation of melanocytic dendrites. The population “in need thereof” would be clear to one of ordinary skill in the art such as a dermatologist or anesthetist.

In view of Applicants’ amendments and arguments, reconsideration and withdrawal of the above ground of rejection is respectfully requested.

#### **Rejection under 35 U.S.C. § 102(b)**

Claims 7 and 12-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Remberg, et al. (WO 02/41909).

Remberg teaches treatment of urticaria with plant extracts which include centaureidin. The Examiner takes the position that the claims are indefinite and read upon any skin condition. As urticaria is a skin condition, the Office Action asserts that the present claims are anticipated by Remberg.

This ground of rejection is addressed first by amendment of claims 7 (and similarly claim 12) to “applying Centaureidin .... to the skin of an individual in need of skin whitening, whereby

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elongation of melanocytic dendrites is inhibited” as discussed above in addressing the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph. Furthermore, the preamble of claims 7 and 12 now recites to “A method for whitening skin...”.

A person desiring skin whitening would not turn to the teaching of Remberg, et al. on urticaria. Urticaria is a skin disease characterized by itching which is not associated with any characteristic pigmentation. Accordingly, there would be no expectation of success that treatment of skin as taught by Remberg, et al. would result in skin whitening.

Furthermore, new claims 14-17 are directed to dyschromatosis. Dyschromatosis is a different disease from Urticaria. The disease populations for these two conditions are distinct. Accordingly, in treating an individual for Urticaria, it is most unlikely that you would also be treating dyschromatosis. Dictionary definitions for both conditions are attached hereto.

Urticaria is an allergic reaction characterized by itching. On the other hand, dyschromatosis is a condition of hypo- and hyperpigmentation. Urticaria relates to discomfort. Dyschromatosis relates to skin appearance. While both are skin disorders, there would be no correlation between a person suffering from urticaria and a person having dyschromatosis.

In view of Applicants’ amendments and arguments, reconsideration and withdrawal of the above ground of rejection is respectfully requested.

#### **Rejection under 35 U.S.C. § 103(a)**

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Remberg, et al. (WO 02/41909) as evidenced by Applicants’ own Declarations.

Claim 9 depends from claim 7 and is believed to be patentable in view of the amendments to claim 7 discussed above.

There is no apparent reason for one of ordinary skill in the art, who would be a dermatologist or anesthetist familiar with dyschromatosis and urticaria, to apply a treatment as taught by Remberg, et al to an individual desiring whiter skin or suffering from dyschromatosis as urticaria is not a condition associated with hyperpigmentation. One of ordinary skill in the art, familiar with the teaching of Remberg, et al. on urticaria, would not have any reason to apply centaureidin to the skin of an individual to whiten skin and treat dark complexion and/or dyschromatosis.

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Furthermore, as discussed above, the disease populations for urticaria and dyschromatosis are completely different so by practicing the method taught by Remberg, et al. you would not also be treating an individual having dyschromatosis.

In view of Applicants' amendments and arguments, reconsideration and withdrawal of the above ground of rejection is respectfully requested.

#### **No Disclaimers or Disavowals**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

#### **Co-Pending Applications of Assignee**

Further to the listings provided April 9, 2008 and October 28, 2008, Applicant wishes to draw the Examiner's attention to the following co-pending application of the present application's assignee.

<b>Docket No.</b>	<b>Serial No.</b>	<b>Title</b>	<b>Filed</b>
TOYA107.016APC	12/514132	SKIN EXTERNAL PREPARATION IN THE FORM OF WATER-IN-OIL EMULSION COMPRISING CERAMIDE	08-May-2009

#### **CONCLUSION**

In view of Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the

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application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Oct. 29, 2009

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dyschromatosis

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An asymptomatic anomaly of pigmentation occurring among the Japanese; may be localised or diffuse.

Origin: dys-+ G. Chroma, colour, + -osis, condition

(05 Mar 2000)

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# urticaria

## Definition from Wiktionary, a free dictionary

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## English

### Pronunciation

■

Rhymes: -ɛəriə

## Noun

**urticaria** (*uncountable*)

1. (*pathology*) Itchy, swollen, red areas of the skin which can appear quickly in response to an allergen or due to other conditions

## Synonyms

- hives
- nettle-rash

## Translations

medical condition

[show ▼]

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Categories: English nouns | Diseases

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